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Charles A. Muserlian
Bierman, Muserlian and Lucas
600 Third Avenue
New York, NY 10016

In re Application of	:	
DUBOIS	:	DECISION ON
Application No.: 09/194,996	:	
PCT No.: PCT/FR97/01024	:	RENEWED PETITION
Int. Filing Date: 10 June 1997	:	
Priority Date: 11 June 1996	:	UNDER 37 CFR 1.47(b)
Attorney's Docket No.: 146.1309	:	
For: TRANSDERMIC SYSTEMS ...	:	
MEDICAMENTS	:	

This decision is in response to the third renewed petition under 37 CFR 1.47(b) filed 12 January 2001.

BACKGROUND

On 10 June 1997, applicant filed international application PCT/FR97/01024, which claimed a priority date of 11 June 1996. A copy of the international communication was communicated to the United States Patent and Trademark Office from the International Bureau on 18 December 1997. A Demand for international preliminary examination in which the United States was elected, was filed on 31 December 1997, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 11 December 1998.

On 04 December 1998, applicant filed, in the United States Patent and Trademark Office (USPTO), a transmittal letter requesting entry into the U.S. national stage, which was accompanied by, *inter alia*, the requisite U.S. basic national fee and an unexecuted declaration.

On 20 April 1999, the USPTO mailed applicants a NOTIFICATION OF MISSING REQUIREMENTS (PCT/DO/EO/905) and a NOTIFICATION OF A DEFECTIVE OATH OR DECLARATION (PCT/DO/EO/917) which indicated that the oath or declaration was not properly executed, and set a one month time period for response.

On 20 September 1999, applicants filed a "COMPLETION OF APPLICATION". The submission included, *inter alia*, a petition under 37 CFR 1.47(b); a declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventors; a "Declaration Under

Rule 47" by Jean-Claude Vieillefosse (hereinafter "first declaration of facts"); and Exhibits A-F:

- Exhibit A, a declaration of designation of inventors signed by Mr. Dubois;
- Exhibit B, copy of French law;
- Exhibit C, copy of employment contract;
- Exhibit D, copy of letter written to Mr. Dubois on 09 November 1998;
- Exhibit E, copy of fax to Mr. Dubois sent on 02 December 1998; and
- Exhibit F, copy of letter forwarded to Mr. Dubois on 30 December 1998.

On 14 February 2000, the USPTO mailed a decision dismissing applicant's petition under 37 CFR 1.47(b). Specifically, the decision noted that the following had not been provided: factual proof that the inventor refuses to execute the application; a statement of the last known address of the inventor; an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor; and proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application.

On 21 March 2000, applicants filed a renewed petition under 37 CFR 1.47(b). The renewed petition was accompanied by a "Supplemental Declaration Under Rule 47" (hereinafter "second declaration of facts") by Jean-Claude Vieillefosse.

On 23 March 2000, applicants filed a "Supplement to the Renewed Petition" accompanied by an "Extract from the minutes of the Board of Executive Directors' deliberations dated Thursday 10 December 1998 at 2:00PM" and an English translation thereof.

On 26 July 2000, the USPTO mailed a decision dismissing applicant's renewed petition under 37 CFR 1.47(b). Specifically, the decision noted that the following had still not been provided: a statement of the last known address of the inventor; an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor; and proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application.

On 03 August 2000, applicants filed the instant second renewed petition under 37 CFR 1.47(b).

On 14 December 2000, the USPTO mailed a decision dismissing applicant's second renewed petition under 37 CFR 1.47(b). Specifically the decision noted that proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application had still not been provided.

On 12 January 2001, applicant submitted a third renewed petition, which was accompanied by a declaration of Jean-Claude Vieillefosse.

On 17 May 2001, the USPTO mailed a decision dismissing applicant's third renewed petition under 37 CFR 1.47(b). Specifically, it was again noted that proof that the 37 CFR

1.47(b) applicant has sufficient proprietary interest in the application had still not been provided.

On 06 July 2001, applicant submitted the instant fourth renewed petition.

DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by: (1) the fee under 37 CFR 1.17(h), (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage. It was noted in the decision mailed 14 February 2000 that applicant has satisfied items (1) and (6) above. The decision mailed 26 July 2000 noted that applicant has also satisfied item (2). The decision mailed 14 December 2000 indicated that items (3) and (4) had also been satisfied. All of the decisions indicated that item (5) had not been met.

The fourth renewed petition urges that it has been established that "Mr. Dubois was required to assign all invention to Hoechst Marion Roussel during his employment." However, this statement again ignores the English translation of Exhibit B, Art. L. 611-7 discussed in the decision mailed 17 May 2001 (page 3) and the decision mailed 14 December 2000 (pages 3-4). It is also noted that the filing of a priority application in the name of Mr. Dubois during the time of his employment is not proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application. The fourth renewed petition also urges that the "statements by Mr. Vieillefosse have been made under Declaration form and have to be accepted at face value." However, the statements made by Mr. Vieillefosse are insufficient for the reasons set forth in the decision mailed 17 May 2001 (page 4).

Attention is directed to MPEP § 409.03(f) for information regarding proof of proprietary interest.

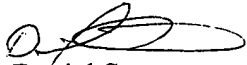
CONCLUSION

For the above reasons, applicants' second renewed petition under 37 CFR 1.47(b) is **DISMISSED**, without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)", whichever is appropriate. No additional petition fee is required.

Any further correspondence with respect to this matter should be addressed to the

Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of this letter marked to the attention of the Office of PCT Legal Administration.



Daniel Stemmer
PCT Legal Examiner
PCT Legal Affairs
Office of Patent Cooperation Treaty
Legal Administration
Telephone: 703-308-2066
Facsimile: 703-308-6459